

Application No. 09/501,540
Amendment dated May 30, 2006
Response to Office action date January 27, 2006

Remarks/Arguments

Claims 28-37 are in the application. Claim 28 is in independent form.

Overview of Differences Between Preferred Embodiments and Wang

Wang describes a system that adds machine-readable information to a document so that the document can be automatically processed. Wang's system processes two categories of documents: documents that include pre-printed machine readable information, and documents that do not include machine readable information. Col. 4, lines 40-54. For documents that do not include machine-readable information, manual indexing is required, that is, a person must intervene in the process to read the document and manually enter information describing the document. Col. 4, lines 43-46. The document is then reprinted with the indexing information in machine-readable code printed on the document.

Wang's second category, documents that include pre-printed machine-readable information, include tax returns (FIG. 10), medical note pads (FIG. 7), checks (FIG. 9) and identification cards (FIG. 8). The form image can be scanned and stored, with the machine-readable data indicating what the data is and how to store it.

Wang requires manual intervention to process documents that do not include preprinted machine-readable identification. On the other hand, the claimed invention allows processing of documents that do not include machine readable identification without human intervention, thereby providing a significant advantage over Wang.

Claims Rejections Under 35 USC § 103

Claims 28 and 30-37 are rejected under 35 USC 103(a) as being unpatentable over U.S. Pat. 5,490,217 to Wang et al. ("Wang") in view of U.S. Pat. Publ. No. US2001/0011246A1 to Tammaro ("Tammaro") and in view of Webster's II New College Dictionary.

Claim 28 includes transmitting an electronic application form to an applicant to complete, receiving the electronic form including information entered by the applicant; generating a document request bearing machine readable code and human readable information and transmitting the request to a third party, retrieving from the third party the document requested together with the request, and automatically associating the document with the application.

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Wang simply does not teach such a procedure. From col. 4, line 60, to col. 6, line 29, Wang teaches in general the use of machine readable information on documents. Wang further provides several examples of his general technique from col. 5, line 30, to col. 7, line 15. While the steps show documents being sent from one party to another, neither the general information nor the specifics show the steps of claim 28, which is why Wang requires manual intervention when a document does not include machine readable information. The steps of claim 28 overcome that limitation of Wang.

On page 3 of the Office action, the Examiner states that "Wang describes automatically generating a request bearing a machine readable code (shown as reference sign 16 in Figs. 5, 7-10, and at column 3, lines 6-16)." Applicants respectfully submit that while the cited Figures show a machine readable code, they do not show "automatically generating a request . . . specifying a document to be retrieved and associated with an electronic form." Fig. 5 shows a machine readable code only, not a request for a document to be associated with an electronic application. Fig. 7 shows a doctor's note pad including a machine readable code to facilitate storing and retrieving the doctor's notes. FIG. 7 does not show a "request for a document to be associated with the electronic application;" the medical notes are not transmitted as a request for a document to a third party and no document requested is received together with the medical notes and automatically associated with a third document, *e.g.*, an application. Similarly, the drivers license of FIG. 8, the check of FIG. 9, and the tax form of FIG. 10 are not requests for document that are transmitted to third parties and then returned along with the requested document and associated with a third document.

None of the passages cited by the Examiner describe transmitting an electronic application, receiving a completed electronic application, automatically generating a request specifying a document to be retrieved, transmitting the request to a third party, receiving from the third party as facsimile data the document requested and the request, and determining from the machine readable data the electronic application form with which to associate the document.

Col. 2, lines 61-67, state that the system can generate a document in human readable form that includes a machine readable image code. The document generated is not a request specifying a document to be retrieved, and there is no teaching of sending the document to a third party and then getting back the request along with the requested document. Col. 7, lines

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62-67, teach a utilization unit that makes the document content available to be reviewed, revised, or replaced; it does not teach automatically generating a request specifying a document to be retrieved, transmitting the request to a third party, receiving from the third party as facsimile data the document requested and the request, and determining from the machine readable data the electronic application form with which to associate the document.

Col. 4, lines 54-65, teach that the "machine readable code 16 document (the second category) can be scanned by a page scanner . . ." By "second category" is meant processing a document that includes a machine readable code. Col. 4, lines 49-51. Claim 28 teaches a method of processing a document that lacks a machine readable code. Part of the processing includes sending a request having bearing machine readable code for the document, receiving via facsimile the document with the request, and reading the machine readable code on the request to process the attached document. While Wang does teaches processing a document having a machine readable code, which is a part of claim 28, Wang does not teach the additional steps of claim 28 required for processing a document without machine readable code.

The Examiner cites col. 2, line 7; col. 4, line 3; col. 2, line 30; and col. 2, line 7, for various propositions, such as "encoding identifying content," "relating documents to an identified entity," and "fax communication," but those passages related to documents that include machine readable code, not document without a machine readable code. Wang does not teach how to how to associate a document from a third party without a machine readable code to an application form from an applicant.

The Examiner states that Wang anticipates "automatically determining from the facsimile data the identifying information and associating the facsimile data with the application, whereby the third party uses only a facsimile transmission device to transmit the document in electronic form and the machine readable identifying information facilitates automatic matching of the document with the application at the institution." Applicants submit that the quote does not correspond to claim 28 as filed June 21, 2006. Also, Wang shows in FIG. 1 that both parties to the document transaction include a host computer with either a coder or a decoder for encoding or decoding the machine readable code. Thus, Wang does not teach a third party using only a facsimile machine; the party also needs an encoder or decoder. In the invention of claim 28, the third party does not need an encoder or decoder. The secondary references do not provide the

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elements described above as missing from Wang.

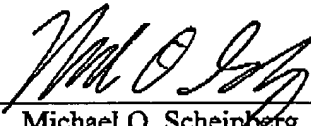
Applicant submits that claims 30-37 are patentable for the reasons described above with respect to claim 28.

Claims 29 is rejected under 35 USC 103(a) as being unpatentable over Wang in view of Tammaro and Webster's, further in view of U.S. Pat. No. 5,853,197 to Mowry et al. ("Mowry")

Applicant submits that claim 39 is patentable for the reasons described above with respect to claim 28.

Respectfully submitted,

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